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EXAMINER

POKRZYWA, JOSEPH R

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 08/12/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/314,960

Applicant(s)

IIDA, JUNICHI

Examiner

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-59 is/are pending in the application.
- 4a) Of the above claim(s) 32-38 and 50-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-31, 39-49 and 57-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 May 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 12.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 5/20/03, and has been entered and made of record. Currently, **claims 20-59** are pending, with **claims 32-38 and 50-56** withdrawn from consideration, as being drawn to a non-elected invention.

Election/Restrictions

2. Applicant's election with traverse of **claims 20-31 and 39-49** (Group I) in Paper No. 9 is acknowledged. The traversal is on the ground(s) that the inventions defined by the groups of claims are so closely related that a restriction requirement is inappropriate, and further, no showing of a serious burden on the Examiner can be made in the present application, making the restriction requirement, once again, inappropriate. This is not found persuasive because the inventions defined by the claims of Groups I and II may both comprise a communication apparatus connected to a terminal over a network, however, each are subcombinations that have far different features and utility. Specifically, the invention of Group I comprises an address book stored on a server which is viewable by a user on a computer terminal, so as to send a message to a recipient in the address book, while the invention of Group II comprises a system that stores received images for a changeable, set period of time, and deletes the stored images when the period of time is exceeded. These inventions are distinct, since the invention of Group I has a separate utility, such as a facsimile server capable of transmitting received faxes as email depending on a destination address stored in an address book, while the invention of Group II

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has a separate utility, such as network computer that stores received e-mail image data for a set period of time, wherein the storage time is reconfigurable. Both of these inventions are classified in different areas within the art, therein attaining a separate status, further making a search for the invention of Group I different than a search for the invention of Group II, thus being a serious burden on the examiner. Because of this, the restriction for examination purposes as indicated remains proper.

The requirement is still deemed proper and is therefore made FINAL.

Response to Arguments

3. Applicant's arguments with respect to **claims 20 and 39** have been considered but are moot in view of the new ground(s) of rejection.

Information Disclosure Statement

4. The references listed in the Information Disclosure Statements submitted on 3/17/03 have been considered by the examiner (see attached PTO-1449).

Drawings

5. The corrected or substitute drawings were received on 5/20/03. These drawings are acceptable.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. **Claims 20-23, 25, 27-31, 39-42, 44, 46-49, and 57** are rejected under 35 U.S.C. 102(e) as being anticipated by Smith *et al.* (U.S. Patent Number 6,385,655).

Regarding **claim 20**, Smith discloses a communication apparatus (dedicated server 22) connected to a terminal apparatus (sending computer 14) via a network (electronic network 18), with the communication apparatus (server 22) comprising a memory that stores an address book including a plurality of destination addresses (column 10, lines 7 through 17), the address book being stored as a HTML file (see Fig. 5, column 2, lines 44 through 57, column 3, lines 37 through 54, and column 10, lines 7 through 59), a transmitter that transmits image data to a designated destination address which is stored in the address book (column 5, lines 48 through 61, and column 11, line 37 through column 12, line 35), the image data being transmitted via at

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least one of the network or a telephone network (column 5, lines 48 through 61), a communicator that transmits the address book to the terminal apparatus when a request for the address book is received from the terminal apparatus (column 10, lines 3 through 32), the address book being displayable at the terminal apparatus (column 10, lines 3 through 32, see Figs. 1, 4, and 5), and a controller that, in response to an instruction from the terminal apparatus, transmits at least one input screen (see Figs. 1, 4, and 5), associated with the address book, to the terminal apparatus, the input screen having an input field enabling modification of a destination address (column 10, lines 25 through 38, see Fig. 5), the screen configured so that the address book can be modified from the terminal apparatus (column 10, lines 3 through 59).

Regarding *claim 21*, Smith discloses the apparatus discussed in claim 20 above, and further teaches that the controller deletes a designated destination address in the address book, in accordance with an instruction from the terminal apparatus (“delete” button 130, column 10, lines 29 through 38, column 15, line 24 through column 16, line 39, and column 19, lines 21 through column 20, line 40, see Fig. 24).

Regarding *claim 22*, Smith discloses the apparatus discussed in claim 20 above, and further teaches that the controller adds a destination address into the address book, in accordance with an instruction from the terminal apparatus (column 10, lines 7 through 38, column 15, line 24 through column 16, line 50, and column 19, lines 21 through column 20, line 40, see Figs. 24 and 25).

Regarding *claim 23*, Smith discloses the apparatus discussed in claim 20 above, and further teaches that the controller edits a designated destination address in the address book, in accordance with an instruction from the terminal apparatus (column 10, lines 7 through 38,

column 15, line 24 through column 16, line 50, and column 19, lines 21 through column 20, line 40, see Figs. 24 and 25).

Regarding **claim 25**, Smith discloses the apparatus discussed in claim 20 above, and further teaches that the address book includes e-mail addresses as the destination addresses (column 8, lines 1 through 6, see Figs. 24 and 25).

Regarding **claim 27**, Smith discloses the apparatus discussed in claim 20 above, and further teaches that the server transmitting the address book and menu items to the terminal apparatus (column 10, lines 3 through 44, and column 19, line 26 through column 20, line 40, seen in Figs. 24 and 25), wherein the address book and the menu items are displayed as single image at the terminal apparatus, the menu items being utilized to change a content of the address book (see Figs. 5, 24, and 25).

Regarding **claim 28**, Smith discloses the apparatus discussed in claim 27 above, and further teaches that the menu items comprise an adding key that adds a destination address (“add addresses” key 452, seen in Fig. 24, and “add” key, seen in Fig. 25).

Regarding **claim 29**, Smith discloses the apparatus discussed in claim 27 above, and further teaches that the menu items comprise a deleting key that deletes a destination address (delete key 130, seen in Fig. 5, and delete keys 450, 468 and 470, seen in Fig. 24).

Regarding **claim 30**, Smith discloses the apparatus discussed in claim 27 above, and further teaches that the menu items comprise an edit key that instructs editing a destination address (“replace” key, seen in Fig. 25).

Regarding **claim 31**, Smith discloses the apparatus discussed in claim 20 above, and further teaches that the terminal apparatus comprises a personal computer (see Fig. 1).

Regarding **claim 39**, Smith discloses a communication method using a communication apparatus (dedicated server 22) connected to a terminal apparatus (sending computer 14) via a network (electronic network 18), with the communication apparatus (server 22) comprising storing an address book including a plurality of destination addresses into a memory (column 10, lines 7 through 17), the address book being stored as a HTML file (see Fig. 5, column 2, lines 44 through 57, column 3, lines 37 through 54, and column 10, lines 7 through 59), transmitting image data to a designated destination address which is stored in the address book (column 5, lines 48 through 61, and column 11, line 37 through column 12, line 35), the image data being transmitted via at least one of the network or a telephone network (column 5, lines 48 through 61), transmitting the address book to the terminal apparatus when a request for the address book is received from the terminal apparatus (column 10, lines 3 through 32), the address book being displayable at the terminal apparatus (column 10, lines 3 through 32, see Figs. 1, 4, and 5), and controlling, in response to an instruction from the terminal apparatus, transmission of at least one input screen (see Figs. 1, 4, and 5) associated with the address book, to the terminal apparatus, the input screen having an input field enabling modification of the destination address (column 10, lines 25 through 38, see Fig. 5), modification of the address book from the terminal apparatus being enabled by the input screen (column 10, lines 3 through 59).

Regarding **claim 40**, Smith discloses the method discussed in claim 39 above, and further teaches that the controlling deletes a designated destination address in the address book, in accordance with an instruction from the terminal apparatus ("delete" button 130, column 10, lines 29 through 38, column 15, line 24 through column 16, line 39, and column 19, lines 21 through column 20, line 40, see Fig. 24).

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Regarding *claim 41*, Smith discloses the method discussed in claim 39 above, and further teaches that the controlling adds a destination address into the address book, in accordance with an instruction from the terminal apparatus (column 10, lines 7 through 38, column 15, line 24 through column 16, line 50, and column 19, lines 21 through column 20, line 40, see Figs. 24 and 25).

Regarding *claim 42*, Smith discloses the method discussed in claim 39 above, and further teaches that the controlling edits a designated destination address in the address book, in accordance with an instruction from the terminal apparatus (column 10, lines 7 through 38, column 15, line 24 through column 16, line 50, and column 19, lines 21 through column 20, line 40, see Figs. 24 and 25).

Regarding *claim 44*, Smith discloses the method discussed in claim 39 above, and further teaches that the address book includes e-mail addresses as the destination addresses (column 8, lines 1 through 6, see Figs. 24 and 25).

Regarding *claim 46*, Smith discloses the method discussed in claim 39 above, and further teaches of transmitting the address book and menu items (column 10, lines 3 through 44, and column 19, line 26 through column 20, line 40, seen in Figs. 24 and 25), wherein the address book and the menu items are displayed as single image at the terminal apparatus, the menu items being utilized to change a content of the address book (see Figs. 5, 24, and 25).

Regarding *claim 47*, Smith discloses the method discussed in claim 46 above, and further teaches that the menu items comprise adding a destination address (“add addresses” key 452, seen in Fig. 24, and “add” key, seen in Fig. 25).

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Regarding *claim 48*, Smith discloses the method discussed in claim 46 above, and further teaches that the menu items comprise deleting a destination address (delete key 130, seen in Fig. 5, and delete keys 450, 468 and 470, seen in Fig. 24).

Regarding *claim 49*, Smith discloses the method discussed in claim 46 above, and further teaches that the menu items comprise editing a destination address (“replace” key, seen in Fig. 25).

Regarding *claim 57*, Smith discloses the apparatus discussed above in claim 20, and further teaches that the controller modifies a designated destination address, in accordance with an instruction from the terminal apparatus (column 19, line 35 through column 20, line 40).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 24, 26, 43, and 45** are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith *et al.* (U.S. Patent Number 6,385,655) in view of Rachelson (U.S. Patent Number 6,157,706, cited in the Office action dated 3/11/03).

Regarding **claims 24 and 43**, Smith discloses the apparatus and method discussed above in claims 20 and 39, respectively, but fails to specifically teach if the address book includes telephone numbers as the destination addresses. Rachelson discloses a communication apparatus (administrative site 100) connected to a terminal apparatus (facsimile machines 110 and computer 120) via a network (see Figs. 1, 4A-4C), with the communication apparatus comprising a memory (address book) that stores an address book including a plurality of destination addresses (see Figs. 9A, column 8, line 4 through column 9, line 35). Further, Rachelson teaches that the address book includes telephone numbers as the destination addresses (see Fig. 9A, column 6, line 45 through column 7, line 6, column 8, lines 15 through 28, and column 10, line 21 through column 11, line 29). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Rachelson's teachings in the system of Smith. Smith's system would easily be modified to include the teachings of Rachelson, since the systems share cumulative features, being additive in nature, thereby making a system that is

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more user-friendly, as the modified address book would further allow the user to select telephone numbers as destinations.

Regarding *claims 26 and 45*, Smith discloses the apparatus and method discussed above in claims 20 and 39, respectively, but fails to specifically teach if the address book includes a destination name and a type of communication, of each destination address, the type of communication indicating one of a facsimile communication and an e-mail communication. Rachelson discloses a communication apparatus (administrative site 100) connected to a terminal apparatus (facsimile machines 110 and computer 120) via a network (see Figs. 1, 4A-4C), with the communication apparatus comprising a memory (address book) that stores an address book including a plurality of destination addresses (see Figs. 9A, column 8, line 4 through column 9, line 35). Further, Rachelson teaches that the address book includes a destination name and a type of communication, of each destination address, the type of communication indicating one of a facsimile communication and an e-mail communication (see Fig. 9A, column 8, lines 15 through 28, and column 10, line 21 through column 11, line 29). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Rachelson's teachings in the system of Smith. Smith's system would easily be modified to include the teachings of Rachelson, since the systems share cumulative features, being additive in nature, thereby making a system that is more user-friendly, as the modified address book would further allow the user to select telephone numbers as destinations.

10. **Claims 58 and 59** are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith *et al.* (U.S. Patent Number 6,385,655) in view of Mori (U.S. Patent Number 6,384,927).

Regarding **claims 58 and 59**, Smith discloses the apparatus and method discussed above in claims 20 and 39, respectively, but fails to teach of a scanner and a printer. Mori discloses a communication apparatus (FI1) connected to a terminal apparatus (computer CL1 or CL2) via a network (LAN1), with the communication apparatus comprising a memory (parameter memory) that stores an address book including a plurality of destination addresses (see Figs. 3A and 3B, column 10, lines 27 through 39). Further, Mori teaches that the communication apparatus includes a scanner and a printer (see Fig. 2, scanner 5 and plotter 6). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Mori's teachings in the system of Smith. Smith's system would easily be modified to include the teachings of Mori, as including a scanner and printer in a store and forward type server was well known in the art, as recognized by Mori, thereby having more options available to a user for transmitted and received messages.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

J.R.P.

Joseph R. Pokrzywa
Examiner
Art Unit 2622

jrp
August 7, 2003

Edward L. Coles
EDWARD COLES

SUPERVISORY PATENT EXAMINER
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